HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10004537-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):	**Travis J. Parry**	**Confirmation No.:**	**9347**
Application No.:	**09/812,047**	**Examiner:**	**Beemnet W. Dada**
Filing Date:	**3/19/01**	**Group Art Unit:**	**2135**

Title: Public Encryption of a Stored Print Job

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 18, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $120	☐ 2nd Month $450	☐ 3rd Month $1020	☐ 4th Month $1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of $ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,
Travis J. Parry
By _____
M. Paul Qualey, Jr.
Attorney/Agent for Applicant(s)
Reg No. : 43,024
Date : 3/6/06
Telephone : (770) 933-9500

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

Travis J. Parry

Serial No.: 09/812/047

Filed: 3/19/01

For: Public Encryption of a Stored Print Job

Confirmation Number: 9347

Group Art Unit: 2135

Examiner: Beemnet W. Dada

Docket No. 10004537-1

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Stephanie Riley
Signature –

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner Beemnet W. Dada, Group Art Unit 2135, mailed October 20, 2005, rejecting claims 14, 15, 18, 19 and 21 in the present application and making the rejection FINAL.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 14, 15, 18, 19 and 21 remain pending

IV. STATUS OF AMENDMENTS

A final Office Action was mailed on October 20, 2005. Applicants responded to that final Office Action on December 14, 2005, at which time arguments for allowability (without amendments) were presented. An Advisory Action of January 9, 2006, the Examiner indicated that the Applicant's remarks did not place the application in condition for allowance, thereby maintaining the rejections. A copy of the current claims is attached hereto as Exhibit A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

In this regard, the invention generally relates to systems and methods for transmitting a secure print job to a selected recipient. A representative embodiment of such a system (such as recited in independent claim 14) comprises a first peripheral device (see reference number 14 of FIGs. 1 and 2 and accompanying description at page 4, line 31 to page 8, line 10, for example). The first peripheral device comprises: a processor (see reference number 20 of FIGs. 1 and 2 and accompanying description at page 5, line 3 to page 8, line 10, for example) for receiving a data stream through a network; an encryption module (see reference number 34 of FIGs. 1 and 2 and accompanying description at page 5, line 26 to page 8, line 10, for example) for converting said data stream from plain text to cipher text; memory (see reference number 22, 24 of FIGs. 1 and 2 and accompanying description at page 5, line 3 to page 8, line 10, for example).for storing the cipher text until access to said cipher text by a user is authorized; a printing mechanism (see FIGs. 1 and 2 and accompanying description at page 4, line 31 to page 5, line 17, for example) for printing a hardcopy document corresponding to the cipher text; and a sender module (see reference number 32 of FIGs. 1 and 2 and accompanying description at page 4, line 31 to page 8, line 10, for example) for transmitting said cipher text through said network to a preselected recipient as an attachment

to an email message. Notably, the following description is provided regarding this embodiment at page 5, line 19 – 22:

> In this embodiment, ***sender module 32 is capable of receiving a digital data file, converting the digital file***, for example, to a PDF or TIFF file, ***and transmitting the file as an e-mail attachment to a preselected recipient*** (*i.e.* host computer or peripheral device).

(Emphasis added).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 14, 15, 18, 19 and 21 stand finally rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Mazzagatte*.

VII. ARGUMENT

A. Rejections under 35 U.S.C. § 102 are Improper as *Mazzagatte* Fails to Teach or Otherwise Disclose All of the Limitations of Applicants' Claims

The final Office Action and subsequent Advisory Action indicate that claims 14, 15, 18, 19 and 21 are rejected under 35 U.S.C. § 102(e) as being anticipated over *Mazzagatte*. Applicants respectfully traverse on the ground that *Mazzagatte* fails to teach or otherwise disclose all of the limitations of the pending claims.

B. Independent Claim 14 and Dependent Claims 15, 18, 19 and 21

In this regard, the Office Action indicates that *Mazzagatte* discloses "a sender module for transmitting said cipher text through said network to a preselected recipient as an attachment to an email message." Specifically, the Office Action and Advisory Action indicate that column 6, lines 25 - 31 of *Mazzagatte* teaches these features.

Upon review of that portion of *Mazzagatte*, notably, that portion discloses:

> Lastly, e-mail program 359 is a typical e-mail program for enabling printer 50 to receive e-mail messages from network 100. ***Such e-mail messages may contain print job-related information, as discussed in more detail below.***

(*Mazzagatte* at column 6, lines 25 - 31). (Emphasis added).

The portion referred to in *Mazzagatte* as providing more detail is reproduced in pertinent part below. In particular, that portion of *Mazzagatte* discloses:

> As seen in FIG. 5, in step S501 ***the sender submits the print job along with unique identification information***, sometimes called a distinguished name, identifying the person who is the intended recipient. This information is generally contained in a digital certificate. ***The identification information links the print job to the intended recipient, so that only the intended recipient is able to print the print job. More specifically, identification information such as the intended recipient's first name, last name, country, locality (city), organization, organization unit, or other information that is unique to him is linked to the print job.***
>
> ***This information*** may be obtained and linked to the print job by various methods. For example, the sender could insert a smart-card into a smart-card reader located at the sending node, such as smart-card reader 15 connected to computer 10 as seen in FIG. 1. The smart-card could contain the recipient's unique identification information in digital form which is supplied to the computer through smart-card interface 265. ***Alternatively, the information may be obtained from a digital certificate, obtained via a Public Key Infrastructure, over the internet, by e-mail or some other means***. In this case, the information could be downloaded to computer 10 over the internet to be subsequently submitted with the print job.

(*Mazzagatte* at column 8, lines 19 - 43). (Emphasis added).

Notably, the use of email referred to in the above passage is only for providing the unique identification information, and not cipher text corresponding to a data stream that was converted by an encryption module.

Perhaps even more notable is the following disclosure of *Mazzagatte*, namely, "Lastly, email program 359 is a typical e-mail program for enabling printer 50 to receive e-mail messages from network 100." (*Mazzagatte* at column 86, lines 25 - 27). Thus, in addition to only disclosing the use of email for receipt of identification information, which

does not correspond to cipher text as recited in claim 14, *Mazzagatte* only discloses an ability to receive email at the printer 50. In contrast, Applicant's claim 14 recites "transmitting said cipher text through said network to a preselected recipient as an attachment to an email message." Applicants respectfully assert that such functionality is not contemplated by *Mazzagatte*.

In this regard, claim 14 recites:

> 14. A printing system comprising:
> ***a first peripheral device comprising:***
> a processor for receiving ***a data stream*** through a network;
> an encryption module for converting ***said data stream from plain text to cipher text***;
> memory for storing the cipher text until access to said cipher text by a user is authorized;
> ***a printing mechanism*** for printing a hardcopy document corresponding to the cipher text; and
> ***a sender module for transmitting said cipher text through said network to a preselected recipient as an attachment to an email message.***

(Emphasis added).

Applicants respectfully assert that *Mazzagatte* is legally deficient for the purpose of anticipating claim 14. In particular, Applicants respectfully assert that *Mazzagatte* does not teach or otherwise disclose at least the features/limitations emphasized above in claim 14. Notably, it appears that Applicant's use of antecedent basis of the terms "data streams" and "cipher text" may not have considered. That is, in claim 14 the "cipher text" corresponds to the "data stream" that was converted by the encryption module. Additionally, the "cipher text" is transmitter as an attachment to an email. As mentioned above, *Mazzagatte* is not involved with transmitting cipher text in such a manner, particularly since *Mazzagatte* clearly only discloses the use of email for receiving information. Therefore, Applicant respectfully asserts that claim 14 is in condition for allowance.

Since claims 15, 18, 19 and 21 are dependent claims that incorporate all the features/limitations of claim 14, Applicants respectfully assert that these claims also are in condition for allowance. Additionally, these claims recite other features/limitations that can serve as an independent basis for patentability.

CONCLUSION

Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's final rejection of the pending claims be overruled and withdrawn by the Board, and that the application be allowed to issue with all pending claims.

Please charge Hewlett-Packard Company's deposit account 08-2025 in the amount of $340 for the filing of this Appeal Brief. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 08-2025.

Respectfully submitted,

M. Paul Qualey, Jr., Reg. No. 43,024

(770) 933-9500

VIII. CLAIMS - APPENDIX

1. – 13. (Canceled)

14. (Previously Presented) A printing system comprising:

a first peripheral device comprising:

a processor for receiving a data stream through a network;

an encryption module for converting said data stream from plain text to cipher text;

memory for storing the cipher text until access to said cipher text by a user is authorized;

a printing mechanism for printing a hardcopy document corresponding to the cipher text; and

a sender module for transmitting said cipher text through said network to a preselected recipient as an attachment to an email message.

15. (Original) The system of Claim 14, wherein said data stream comprises text and graphics.

16. – 17. (Canceled)

18. (Previously Presented) The system of Claim 14, wherein said encryption module comprises the pretty good privacy (PGP) encrypting technique.

19. (Original) The system of Claim 14, wherein said sender module converts said cipher text into a PDF or TIFF file and transmits said PDF or TIFF file to said preselected recipient.

20. (Canceled)

21. (Previously Presented) The system of Claim 14, further comprising:

a manual input device operative to receive an input from a user such that, if a user provides an input to the manual input device indicating that the user is an authorized user, the cipher text stored in the memory can be accessed.

IX. EVIDENCE - APPENDIX

None.

IX. RELATED PROCEEDINGS- APPENDIX

None.